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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061456
Party	Plaintiff Graphic Armor, LLC
Correspondence Address	MARK C JOHNSON THE CONCEPT LAW GROUP PA 200 SOUTH ANDREWS AVENUE, SUITE 100 FORT LAUDERDALE, FL 33301 UNITED STATES Info@ConceptLaw.com, mjohnson@conceptlaw.com
Submission	Other Motions/Papers
Filer's Name	Mark C. Johnson
Filer's e-mail	Info@ConceptLaw.com
Signature	/Mark C. Johnson/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Graphic Armor, LLC,
Petitioner,

v.

Church & Dwight Co., Inc.,
Registrant.

Cancellation No. 92061456

Registration No. 4,081,154

For the Mark: ARMOR

Date of Registration: January 3, 2012

Registration No. 4,133,033

For the Mark: ARMOR (+ Design)

Date of Registration: April 24, 2012

Registration No. 4,147,686

For the Mark: ARMOR

Date of Registration: May 22, 2012

PETITIONER’S MOTION FOR JUDGMENT ON THE PLEADINGS

Graphic Armor, LLC (“Petitioner”), moves the Trademark Trial and Appeal Board (“Board”), pursuant to Fed. R. Civ. P 12(c) and 37 C.F.R. § 2.127, for a partial judgment on the pleadings regarding affirmative defenses 1-8, 10, and 12-13 asserted by Registrant Church & Dwight Co., Inc. (“Registrant”) in its Answer to Petitioner’s First Amended Petition to Cancel (“Answer”). Specifically, Petitioner believes that Registrant’s affirmative defenses are insufficient or immaterial and there is no material issue of fact that remains to be resolved as further discussed herein. As such, Petitioner requests the Board enter judgment in Petitioner’s

favor (and/or strike¹) with regard to Affirmative Defenses Numbered 1-8, 10, 12-13 (memorialized in ¶¶ 1-8, 10, and 12-16 of the Answer).

ARGUMENT

“A motion for judgment on the pleadings, which is provided for under Fed. R. Civ. P. 12(c), will be granted only if the moving party clearly establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law. For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party.” *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 U.S.P.Q.2d 1048, 1049 (T.T.A.B. 1992); *see also Int’l Telephone and Telegraph Corp. v. Int’l Mobile Machines Corp.*, 218 U.S.P.Q. 1024, 1026 (T.T.A.B. 1983) (motion for judgment on the pleadings admits, for purposes of the motion, the truth of all the facts averred in the opposing pleading and judgment should be granted only when the merits of the dispute can be determined); TBMP § 504.02.

Here, no material issues of fact remain to be resolved in regard to Registrant’s affirmative defenses 1-8, 10, and 12-13, and based on the undisputed facts, Petitioner is entitled to judgment as a matter of law. As such, said defenses should be dismissed and/or stricken.

A. **Affirmative Defense Nos. 1, 2 & 4**

Regarding Registrant’s First Affirmative Defense memorialized in ¶ 1 of the Answer, Registrant alleges that Petitioner’s specimen of use for Class 10 in its United States Trademark Application Serial No. 85383755 for “GRAPHIC ARMOR” was not in use in U.S. commerce at the time that Petitioner filed that application and therefore the entire application is void and cannot be relied upon by Petitioner in this proceeding. Similarly, Registrant’s Second

¹ The Board also has discretion, *sua sponte*, under Fed. R. Civ. P. 12(f), to strike from any pleading any insufficient defense or immaterial matter.

Affirmative defense memorialized in ¶ 2 of the Answer alleges that the “signature to the Declaration in Petitioner’s Application Serial No. 86383755 affirmed ‘the specimen(s) shows the mark as used on or in connection with the goods/services in the application’ which is untrue in violation of that Declaration and, therefore, the entire application is void for failure to submit a genuine example of use in compliance with the following Declaration signed by the counsel for Petitioner, Mark C. Johnson.” Registrant also asserts the defense in ¶ 4 of the Answer that Petitioner “cannot act as a contract manufacturer as asserted in Class 40 of its Application Serial No. 86383755.”²

First, the adequacy of specimens of use or compliance with statutory filing requirements is solely a matter of ex parte examination, and is not a sufficient defense. *Dragon Bleu, (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925 n.12 (T.T.A.B. 2014); *Flash & Partners S.P.A. v. I. E. Mfg. LLC*, 95 U.S.P.Q. 2D 1813, 1815–1816 (T.T.A.B. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 U.S.P.Q.2d 2035 (T.T.A.B. 1989). Second, even if the Registrant could prove that the specimen of use was invalid, the allegation would not affect Petitioner’s common law rights asserted against Registrant. *See, e.g.*, First Amended Petitioner [Dkt. No. 7], at ¶ 10; *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1736 (T.T.A.B. 2001); *Gilbert/Robinson Inc. v. Carrie Beverage-Missouri Inc.*, 758 F. Supp. 512, 526, 19 USPQ2d 1481, 1489 (E.D. Mo. 1991); *Alfred Dunhill of London, Inc. v. Kasser Distillers Products Corp.*, 350 F. Supp. 1341, 1369 (E.D. Pa. 1972) (even if registrations were procured by fraud, validity of registration will not affect a plaintiff’s common law rights; the affirmative defense fails even if the registrations were fraudulently procured). Accordingly, as a matter of

² To the extent Registrant is alleging Petitioner’s use was unlawful, this is addressed below in Section C, *infra*.

law Registrant cannot succeed on its First, Second, and Fourth Affirmative Defenses and judgment should be entered in favor of Petitioner with regard to the same.

B. Affirmative Defense Nos. 3 & 5

Regarding Registrant's Third and Fifth Affirmative Defenses memorialized in ¶¶ 3 and 5³ of the Answer, Registrant alleges Petitioner's attorney is a material witness, and cannot represent the Petitioner. An affirmative defense is something that, if proven, will reduce or eliminate Petitioner's potential to invalidate or cancel Registrant's marks, even if Petitioner established a *prima facie* case. *See, e.g., Roberge v. Hannah Marine Corp.*, 124 F.3d 199, 199 (6th Cir. 1997) ("An affirmative defense . . . does not negate the elements of the plaintiff's claim, but instead precludes liability even if all of the elements of the plaintiff's claim are proven."). Under the TBMP, the answer may also "state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint." TBMP ¶ 311.02(d). Registrant's allegations in ¶¶ 3 and 5 do not reduce or eliminate Petitioner's potential to invalidate or cancel Registrant's marks. Rather, they are immaterial averments or insufficient defenses that have no operative effect in the context in which it was raised by Registrant, as Registrant has failed to establish how or why Petitioner's counsel is or will likely be a "necessary" witness. *See* 37 C.F.R. ¶ 11.307 ("A practitioner shall not act as advocate at a proceeding before a tribunal in which practitioner is likely to be *necessary* witness"); *see also* T.M.E.P. ¶ 804.04 (discussing the attorney's signature on the declaration is solely done "on behalf of the applicant" based on an expressed or implied power of attorney from the owner).

C. Affirmative Defense Nos. 6 & 10

³ Affirmative Defense No. 5 also alleges the "Declaration of Mark C. Johnson is untrue making the entire Application Serial No. 86383755 void," which is also insufficient as a matter of law. *See supra* Section A (discussing the insufficiency of defenses alleging the failure to comply with statutory guidelines and the unaffected common law rights of the Petitioner).

Regarding Registrant's Sixth Affirmative Defense memorialized in ¶ 6 of the Answer, Registrant asserts that "any prior or current use of the mark Graphic Armor by Petitioner and/or any claimed predecessor in interest was without FDA regulatory compliance and was therefore a per se violation of FDA regulations, making such use not valid use in U.S. Commerce for priority purposes." Registrant's Tenth Affirmative Defense, memorialized in ¶ 10 of the Answer, also asserts unlawful use "as of the filing date of Application Serial No. 86383755, such that Petitioner may not rely upon such alleged use." Essentially, Registrant's Tenth Affirmative Defense (to the extent it is somehow not redundant of Registrant's Sixth Affirmative Defense) is again lodging a collateral attack against Petitioner's application, which is an insufficient defense as a matter of law. *See supra* Section A (discussing the insufficiency of defenses alleging the failure to comply with statutory guidelines and the unaffected common law rights of the Petitioner).

The Board has held that use in commerce may be unlawful only when the issue of compliance has previously been determined (with a finding of non-compliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a *per se* violation of a statute regulating the sale of a party's goods. *Kellogg Co. v. New Generation Foods Inc.*, 6 U.S.P.Q. 2d 2045 (T.T.A.B. 1988). Registrant is only alleging a "per se" violation of a statute. Answer, at ¶ 6. When alleging a "per se" violation of a statute, the Board has held that:

[A] party seeks to show that use by the adverse party was unlawful by virtue of noncompliance with a [] statutory provision, it is incumbent upon the party charging that the use was unlawful to demonstrate by clear and convincing evidence more than that the use in question was not in compliance with applicable

law. Such party must prove also that the noncompliance was material, that is, was of such gravity and significance that the usage must be considered unlawful -- so tainted that, as a matter of law, it could create no trademark rights

General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q. 2d 1270, 1274 (T.T.A.B. 1992).

While alleging Petitioner's use was a "per se" violation, Registrant does not cite to one single statute in which Petitioner is allegedly violating or not in compliance with. *See* Answer, at ¶¶ 6, 10. Furthermore, Registrant does not allege or aver how or why any alleged non-compliance was material. *See id.* Contrarily, Registrant acknowledges, with documentary evidence, that Petitioner "is registered with the FDA as a re-packager/re-labeler of condoms." Answer, at ¶ 5 (citing Exhibit 2 attached to its Answer). For this reason, even viewing the facts in a light most favorable to the Registrant, Registrant's Sixth Affirmative Defense (and its Tenth Affirmative Defense to the extent it is redundant of Registrant's Sixth Affirmative Defense) is insufficient and there is no issue of material fact that Petitioner's use of the mark was lawful. As an aside, Registrant's unlawfulness claim is also irrelevant to Petitioner's second ground for cancellation, i.e., that the ARMOR mark failures to function as a trademark.

D. Affirmative Defense Nos. 7, 8, and 12

Regarding Registrant's Seventh, Eighth, and Twelfth Affirmative Defenses memorialized in ¶¶ 7-8 and 12 of the Answer, Registrant alleges Petitioner was not using the "GRAPHIC ARMOR" trademark in connection with condoms or contract manufacturing in the field of condoms in U.S. commerce, on January 1, 2010 as alleged in Petitioner's Application Serial No. 86383755 and that Petitioner's use (even if "prior to Registrant's use") was "in different channels of trade." Registrant is merely denying Petitioner's claim of priority based on its date of use in commerce or asserting an element in the likelihood of confusion analysis allegedly

weighs in its favor. These are not affirmative defenses. The rules are clear that the Board may strike any immaterial or insufficient defense. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01. Furthermore, mere reiterations of denials that were previously set forth in the answer and do not add anything of substance are redundant and should be stricken as such. *Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 154 (T.T.A.B. 1973). Here, the affirmative defense is merely a conclusory repetition of the Registrant's denials stated earlier in the Answer without providing any amplification or further reason behind the conclusions, or providing Petitioner with any further information about Registrant's defenses or case. Accordingly, as a matter of law Registrant cannot succeed on the defense and judgment should be entered in favor of Petitioner in regard to Registrant's affirmative defenses 7, 8, and 12.

E. **Affirmative Defense No. 13**

Regarding Registrant's Thirteenth Affirmative Defense memorialized in ¶¶ 13-16 of the Answer, Registrant is alleging Petitioner is challenging Petitioner's specimen with its second ground for cancellation; therefore, Registrant asserts that "such a claim must be dismissed." Specifically, Registrant says that the claim cannot be brought before the Board because "the specimens of use cannot be challenged as not functioning as a trademark for the goods under Section 45." Answer, at ¶ 15. Registrant conflates Petitioner's second ground for cancellation. Petitioner's second ground for cancellation is not attacking Registrant's specimens (which is what the cases cited by Registrant in ¶ 14 of its Answer stand for). In fact, Petitioner's allegations on the ground of failure to function as a trademark make no reference at all to Registrant's specimens of use.

Rather, Petitioner's second ground for cancellation makes clear that Registrant's ARMOR mark was not used as source indicator for condoms, nor was it used to distinguish


and/or identify condoms from the same or similar goods made, manufactured, or sold by others. Amended Petitioner, at ¶¶ 13-14. These allegations are encapsulated under the ground that ARMOR does not function as a trademark. *Id.* at ¶¶ 13-17. This ground is an acknowledged basis to cancel all or part of Registrant's marks. *See* TBMP § 309.03(c) ("Examples of available grounds for opposition and for cancellation are . . . [t]hat the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark"). At best, Registrant is merely reiterating a denial of Petitioner's allegations and has failed to assert any affirmative defense. Therefore, Registrant's Thirteenth Affirmative Defense is immaterial and insufficient such that judgment should be entered in favor of Petitioner as a matter of law.

For the foregoing reasons, Petitioner respectfully requests that the Board enter judgment in Petitioner's favor (and/or strike) with regard to Affirmative Defenses Numbered 1-8, 10, 12-13 (memorialized in ¶¶ 1-8, 10, and 12-16 of the Answer).

Dated: September 17, 2015

Respectfully submitted,

The Concept Law Group, P.A.

By: 
Mark C. Johnson
Museum Plaza
200 South Andrews Avenue, Ste. 100
Fort Lauderdale, FL 33301
Phone: (754) 300-1500
Info@ConceptLaw.com
MJohnson@ConceptLaw.com
Attorney for Petitioner,
Graphic Armor, LLC

Certificate of Service

I certify that on September 17, 2015, the foregoing MOTION FOR JUDGMENT ON THE PLEADINGS is being served via EMAIL (as agreed to by the Parties) to:

Brooks R. Bruneau, Esq.
Attorney for Registrant
Fisher Broyles, LLP
100 Overlook Center
Second Floor
Princeton, NJ 08540
Tel: 609-454-6772
brooks.bruneau@fisherbroyles.com

By:



Mark C. Johnson
Museum Plaza
200 South Andrews Avenue
Suite 100
Fort Lauderdale, FL 33301
(754) 300-1500

Attorney for Petitioner,
Graphic Armor, LLC